

## REMARKS

The Examiner provides a number of rejections and we list them here in the order in which they are addressed:

- I.     Claims 1 – 4 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite.
- II.    Rejections Under 35 USC § 102
  - A.     Claims 1 – 4 are rejected under 35 USC § 102(b) as allegedly being anticipated by US Pat. No. 5,563,146 To Morris et al.
  - B.     Claims 1 – 3 are rejected under 35 USC § 102(e) as allegedly being anticipated by US Pat No. 6,273,913 To Wright et al.
  - C.     Claims 1 – 4 are rejected under 35 USC § 102(e) as allegedly being anticipated by US Pat No. 6,726,923 To Iyer et al.
- III.   Claim 4 is rejected under 35 USC § 103(a) as allegedly being unpatentable over Wright et al., in view of Iyer et al.

### I.     The Claims Are Not Indefinite

The Examiner states that several terms and/or phrases in either Claim 1 and/or Claim 4 result in either indefiniteness or ambiguity. For example, the Examiner alleges that: i) “generally” (pg 6); ii) “being selected from the group that includes” (pg. 6); iii) “any functional analog of sirolimus including” (pg 7); and iv) “... 32-dethoxy, 2-desmethyl and proline” (pg 7) are either indefinite or ambiguous. *Non-Final Office Action, 03/13/06*. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 1 to specify “a suture”. (See, Applicants' priority parent application 09/705,999, filed 11/06/2000; pg. 8 ln 3-12; and Applicants' instant application, 10/072,177; pg 11 ln 14 – pg 12 ln 4). Further, a Markush Group is presented consisting of compounds that all comprise a rapamycin (i.e., sirolimus) structural core<sup>1</sup>. (See, Applicants' priority Patent 6,534,693, filed 01/31/01; col 4 ln 55-59; and Applicants' instant application pg 12 ln 12-

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<sup>1</sup> The Applicants believe that this Markush group is consistent with the “species election”.

18). Dependent Claims 2 – 4 have been concomitantly amended to maintain proper antecedent basis. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application. The Examiner is requested to note new dependent Claim 23, reciting that the suture is attached to a sheet of material.

The Applicants respectfully request that the Examiner withdraw the rejection.

## **II. The Claims Are Not Anticipated**

As the Examiner is well aware, a single reference must disclose each limitation of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with any of the references cited by the Examiner.

### **A. Claims 1 – 4 Are Not Anticipated By Morris et al.**

The Applicants argue that the claim amendments made for other reasons above render this rejection moot. The Applicants respectfully request that the Examiner withdraw this rejection.

### **B. Claims 1 – 3 Are Not Anticipated By Wright et al.**

The Applicants argue that the claim amendments made for other reasons above render this rejection moot. The Applicants respectfully request that the Examiner withdraw this rejection.

### **C. Claims 1 – 4 Are Not Anticipated By Morris et al.**

The Applicants argue that the claim amendments made for other reasons above render this rejection moot. The Applicants respectfully request that the Examiner withdraw this rejection.

## **III. The Claims Are Not *Prima Facie* Obvious**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and MPEP § 2142; Establishing A *Prima Facie* Case Of Obviousness. The Examiner is reminded that if ONLY ONE of the above requirements is not met, then a *prima facie* case of obviousness does not exist. The Applicants submit that the Examiner's rejection does not

meet these criterion. The Applicants rebut the establishment of a *prima facie* case of obviousness by the argument below.

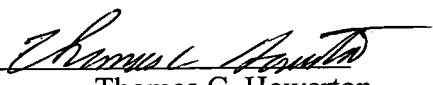
The Examiner asserts that Claims 1 – 4 are allegedly unpatentable over Wright et al. in view of Iyer et al. The Applicants disagree and argue that the claim amendments made for other reasons fully traverse this rejection. Further, the Examiner is reminded that because the claim element “suture” is fully supported by the Applicants’ ‘999 parent application (*supra*), Iyer et al. is not prior art.

Consequently, the Examiner’s rejection fails and the Applicants respectfully request that the Examiner withdraw this rejection.

### CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner’s rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

Date: July 13, 2006

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